

In regard to Groups I and Group II, the Office has characterized the relationship between these groups as product and process of use. Citing MPEP §806.05(h), the Office concludes that the product as claimed can be used in a materially different process because “the bacterium of Invention I can be used... to produce compounds naturally found in that bacterium.” However, the Office has not provided reasons and/or examples to support this conclusion, nor has the Office provided any distinct steps. Further, the Office has failed to show that the proposed use of the claimed product is materially different from the claimed use. Accordingly, Applicants respectfully submit that the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Withdrawal of the Restriction Requirement is respectfully requested.

Applicants also respectfully traverse on the grounds that the Office has not shown that a burden exists in searching the entire application.

Further, MPEP §803 states as follows:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on its merits, even though it includes claims to distinct or independent inventions.

Applicants submit that a search of all claims would not constitute a serious burden on the Office, particularly in view of the fact that the claims of Group II depend directly from the claims of Group I.

Finally, Applicants remind the Examiner of MPEP §821.04

...if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

Upon a finding of allowability of the elected product claims, Applicants respectfully

request rejoinder of withdrawn process claims.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



Stephen G. Baxter  
Attorney of Record  
Registration No. 32,884

Vincent K. Shier, Ph.D.  
Registration No. 50,552

Customer Number  
**22850**

Tel: (703) 413-3000  
Fax: (703) 413-2220  
(OSMMN 08/03)  
SGB:VKS